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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
ON APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

#13
LBJ
5-14-04

In re Application of: Prasad Y. Chebrolu
Serial No.: 09/406,381
Filing Date: September 27, 1999
Group Art Unit: 2155
Examiner: David Y. Eng
Title: SYSTEM AND METHOD FOR SELECTING A MODEM
FOR SERVICE

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Willie Jiles

Willie Jiles

4/7/04

Date

Dear Sir:

REPLY BRIEF

Appellant has appealed to this Board from the decision of the Examiner, contained in
a final Office Action mailed August 8, 2003, finally rejecting Claims 1-36. Appellant
submits this Reply Brief in response to the Examiner's Answer mailed on March 12, 2004.

REPLY

Appellant's Appeal Brief sets out in detail why the claims under appeal are allowable and why the Examiner's final rejection of these claims should therefore be reversed. Appellant respectfully submits that the Examiner's Answer fails to adequately rebut the arguments presented in the Appeal Brief. In the "Response to Arguments" section of the Answer, the Examiner provides an additional analysis of the references. This additional analysis, however, merely emphasizes the failure of the cited reference to teach or suggest elements from Appellant's claims.

The following discussion primarily addresses the points discussed in the Examiner's Response to Arguments without recapitulating the entire analysis provided in the Appeal Brief. However, this short discussion will show that the Examiner's arguments and analysis only lend further support to Appellant's position – that the cited references, *Thaweethai* and *Bush*, whether taken alone or in combination, fail to teach or suggest all elements of Appellant's claims.

The Examiner Misinterprets Legal Authority Regarding Functional Language in Apparatus Claims.

Appellant respectfully disagrees with the Examiner's attempt to modify Appellant's grouping of claims. Specifically, Appellant believes that the claims in Group IIA should not be divided into two mutually exclusive groups.

In support of his grouping of the claims, the Examiner cites M.P.E.P. §2114 and states that:

apparatus claims must be structurally distinguishable from the prior art. Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function.

Examiner's Answer, at page 8. However, the Federal Circuit has affirmed that "[a] patent applicant is free to recite features of an apparatus either structurally *or functionally*." *In re Schreiber*, 128 F.3d 1473, 1478 (Fed. Cir. 1997) (emphasis added). Furthermore, before requiring Appellant to show that the prior art fails to possess the functional characteristic, the Examiner must show that the functional limitations at issue are inherent characteristics of the prior art. *Id.* Because the Examiner must show functional limitations in the apparatus claims that are similar to functional limitations in the method claims, the Examiner's grouping is improper.

Furthermore, Appellant respectfully submits that the Examiner has not met his burden of showing that the functional limitations at issue are inherent characteristics of the prior art. Nevertheless, while not required to do so until the Examiner meets his burden, for reasons substantially similar to those discussed below, Appellant has shown that *Thaweethai* fails to teach or suggest, inherently or otherwise, an allocation module operable to “select a modem for service according to the modem’s performance attribute.”

Moreover, even using the Examiner’s grouping of Claims, Appellant respectfully traverses the Examiner’s statement that *Thaweethai* clearly teaches all the structural limitations of the claims. For example, *Thaweethai* fails to teach or suggest an allocation module as recited in Claim 3.

***Thaweethai* Fails to Show, Either Expressly or Inherently, Every Element of Appellant’s Claims.**

Appellant respectfully submits that *Thaweethai* fails to show, either expressly or inherently, “a performance attribute” as included in various claims. In the Answer, the Examiner first attempts to de-emphasize and ultimately ignore claim language, specifically the term “performance.” The Examiner de-emphasizes “performance” by bolding the terms “stored” and “attributes” but not “performance” when he states that “the claims recite that the modems are selected based on **stored performance attributes**.” *Examiner’s Answer*, at page 7 (emphasis in original). Then, the Examiner eliminates “performance” completely by stating that “Appellants’ [sic] selection of modems is **based on predetermined, pre-stored information**.” *Id.* (emphasis in original). However, as stated in Appellant’s Appeal Brief, to anticipate Appellant’s claims *each and every* element of Appellant’s claims must be either expressly or inherently described a single prior art reference. By seeking to de-emphasize and ultimately ignore the term “performance,” the Examiner highlights one element of Appellant’s claims not shown by *Thaweethai*.

However, after attempting to de-emphasize or ignore the term “performance,” the Examiner does an about-face and cites two new portions of *Thaweethai* as showing selecting a modem based on “dynamically generated performance information.” *Examiner’s Answer*, at page 7. Nevertheless, neither of the newly cited portions show “selecting a modem for service according to the modem’s performance attribute.”

First, the Examiner states that “Thaweethai teaches that all modems are monitored.” *Examiner’s Answer*, at page 7. Appellant respectfully disagrees. The Examiner cites *Thaweethai*, at col. 3, ll. 49-50, for support, but this section states that “[a]ll connections to the remote network are monitored.” Connections are not the same as modems. Regardless, however, monitoring all modems or all connections fails to show “selecting a modem for service according to the modem’s performance attribute.”

Next, the Examiner cites *Thaweethai*’s Abstract, which states that “[a] wide-area computer network system provides bandwidth based on network demand, throughput, and delay requirements.” However, provisioning bandwidth based on one or multiple factors fails to show “selecting a modem for service according to the modem’s performance attribute.” Furthermore, demand and throughput of a wide-area network and delay requirements associated with a wide-area network fails to show “a performance attribute for each of a plurality of modems.”

After failing to point out portions of *Thaweethai* that correspond to the claim language, the Examiner finally states that “the above techniques inherently require dynamically generated performance data.” *Examiner’s Answer*, at page 7. Again, Appellant respectfully disagrees. Based on the first citation, the Examiner is apparently referring to what *Thaweethai* describes as “bandwidth-on-demand” or BOND. BOND seeks to ensure that a multiplexing system makes efficient use of connections (also called links or lines) established between the system and a remote network. The system will add a connection or mark a connection for removal based on one of two calculations. First, if the total number of packets pending transmission on multiple connections exceeds a high water mark value, the system will establish a new connection with the remote network. Second, if the total number of packets on any connection falls below a low water mark value, the system will mark the connection for tearing down, cease using the connection for transmission, but allow the remote network to use the connection. *Thaweethai*, col. 3, ll. 46-65.

Thus, *Thaweethai* discloses monitoring connections and potentially adding or removing a connection based on a current number of packets pending transmission in one or multiple connections. In short, none of these techniques shows, explicitly or inherently, “selecting a modem for service according to the modem’s performance attribute.” Thus, for at least these reasons, the Examiner’s new citations fail to show, either expressly or inherently, each and every element of Appellant’s claims.

***Thaweethai* and *Bush*, Whether Taken Alone or in Combination, Fail to Teach or Suggest Every Element of Appellant's Claims.**

Appellant respectfully submits that *Thaweethai* and *Bush* fail to teach or suggest the claim elements discussed above as well as “monitoring the selected modem’s performance; and modifying the performance attribute for the selected modem according to the modem’s performance,” as recited in Claim 11, and substantially similar elements included in various other claims. Again, the Examiner cites a new portion of the references to support his arguments. Again, however, the new citation fails to teach or suggest the claim language.

The Examiner cites col. 2, ll. 53-57 of *Thaweethai*, which states:

[Modem Pooling Control Function (MPCF)] is also capable of retrieving the connection information such as speed and compression type from the modem response. This information is used to determine the capacity unit (CU) of that connection. The capacity unit is used by the BOND function.

BOND uses the CU “for bandwidth allocation control.” *Thaweethai*, col. 2, ll. 24-25. Thus, these sections merely reaffirm what is discussed above, that *Thaweethai* discloses monitoring connections to provision bandwidth. But monitoring connections to provision bandwidth does not teach or suggest “monitoring the selected modem’s performance; and modifying the performance attribute for the selected modem according to the modem’s performance.” *Thaweethai* simply fails to disclose a performance attribute, let alone modification of a performance attribute based on modem performance.

The Examiner’s Conclusory Statements Fail to Show Any Teaching, Suggestion, or Motivation to Combine the References.

Appellant has presented compelling arguments showing the proposed combination of *Thaweethai* and *Bush* is inappropriate in light of the requirements for combining references. Moreover, Appellant has noted the Examiner’s failure to provide any teaching, suggestion, or motivation for the proposed combination. In the Examiner’s Answer, the Examiner states:

Since *Thaweethai* relies on pre-stored and predetermined performance parameters for selection and the obtained information through monitoring is performance parameters, it would have been notoriously obvious to a person of ordinary skill in the art to update the stored parameters as taught by

Bush such that the selected modem is better match [sic] to the user's requirements.

Examiner's Answer, at page 10. Again, the Examiner's conclusory statement, unsupported by any citation to the references, fails to demonstrate any teaching, suggestion, or motivation for the proposed combination.

CONCLUSION

Appellant thoroughly demonstrated in the Appeal Brief that the Claims are patentable over the cited references. The Examiner's Answer does not in any way controvert Appellant's showing. Rather, as demonstrated in this Reply Brief, the Examiner's Answer merely highlights the inadequacies of the references relied upon for these rejections. Accordingly, Appellant respectfully requests the Board to reverse the Examiner's final rejection of Claims 1-36 and to instruct the Examiner to issue a Notice of Allowance of these Claims.

Although Appellant believes no fee is due in connection with this Reply Brief, the Commissioner is hereby authorized to charge any fee or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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